Remarks/Arguments:

I. Status

The Office Action dated June 9, 2006 (the "Office Action") has been carefully reviewed. In the Office Action:

A. Claim 13 was rejected under 35 U.S.C. §112;

B. Claims 1, 3, 7 and 12-18 were rejected as being anticipated under 35 U.S.C. §102(b) by WO 2001/22905 to Bahler (hereinafter "Bahler");

C. Claims 12-18 were rejected as being anticipated under 35 U.S.C. §102(b) by German Patent No. DE 101 23 517 C1 to Glien et al. (hereinafter "Glien");

D. Claims 1, 3, 7 and 12-18 were rejected as being anticipated under 35 U.S.C. §102(a) by WO 2003/096939 A1 to Horber (hereinafter "Horber")[1]; and

E. Claims 1, 3, 7 and 12-18 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,228,120 to Leonard et al. (hereinafter "Leonard") in view of Horber.

Claims 1, 3, 7 and 12-18 have been canceled. Claims 19-37 have been added. Accordingly, claims 19-37 are pending in this application. Reconsideration of this application, as amended, is respectfully requested.

[1] The Examiner has identified U.S. Patent Publication No. 2005/0113931 as an English translation of Horber. (Office Action at page 5). Accordingly, the citations herein to Horber will be to the U.S. Patent Publication No. 2005/0113931.

II. New Claims

Claims 19-37 have been added. For at least the reasons set forth below, these claims recite novel and non-obvious limitations.

III. The Claims are Patentable over Bahler

The Examiner has previously rejected the Applicants' invention based upon the allegation that Bahler discloses a spherical articulating portion of a mounting element that contacts an interior wall which extends linearly from a ledge to a proximal surface of the stem. (Office Action at page 3). The present claims are distinguishable over Bahler.

Specifically, the Examiner has alleged that Bahler discloses "contact" because "said spherical articulation portion of said mounting element contacts (via rotating piece 22) said linearly extending interior wall." (Office Action at page 3). The Examiner appears to admit that Bahler fails to disclose a mounting element which directly touches a wall of the bore. The Examiner's rejections thus rested upon a construction of "contacts" that includes direct or indirect touching.

The present claims recite limitations wherein the mounting element touches the bore. For example, claim 19 recites a fastener "configured to force the spherical articulating portion against the interior wall" of the bore, claim 27 recites "the spherical articulating portion of the mounting element touches the linearly extending interior wall of the stem" and claim 32 recites "the spherical articulating portion configured for press-fit engagement with the internal bore such that the spherical articulating portion touches the internal bore around substantially an entire perimeter of the bore." All of the remaining claims include the limitations of either claim 19, claim 27 or claim 32.

Therefore, the Applicants respectfully submit that the new claims are patentable over Bahler.

IV. The Claims are Patentable over Glien

The Examiner has previously rejected the Applicants' invention based upon Glien. The present claims are distinguishable over Glien.

Specifically, claim 19 recites "a fastener extending from within the spherical articulating portion to within the second bore portion." The fastener of Glien resides completely within the mounting element. Therefore, Glien fails to disclose all of the limitations of claim 19.

Claim 27 recites "the stem, when viewed in a cross-section, further includes an interior wall portion located within the first coupler bore that extends from the proximal surface in a straight line" and that "the spherical articulating portion of the mounting element touches the interior wall portion at a point along the straight line." As depicted most clearly in FIG. 4, the spherical portion of the Glien mounting element touches the stem 12 at the clamping surfaces 16 and 17 (see FIG. 3). There is no contact between the member 23 and the stem 12 at the area identified by reference number 15. Therefore, Glien fails to disclose all of the limitations of claim 27.

Claim 32 recites "a fastener engaged with the stem." The fastener 30 of Glien does not touch the stem 12 (see, e.g., FIG. 4). Therefore, Glien fails to disclose all of the limitations of claim 32.

All of the remaining claims include the limitations of either claim 19, claim 27 or claim 32. Therefore, the Applicants respectfully submit that the new claims are patentable over Glien.

V. The Claims are Patentable over Horber

Claim 19 recites a fastener "configured to force the spherical articulating portion against the interior wall" of the bore, claim 27 recites "the spherical articulating portion of the mounting element touches the linearly extending interior wall of the stem" and claim 32 recites "the spherical articulating portion configured for press-fit engagement with the internal bore such that the spherical articulating portion touches the internal bore around substantially an entire perimeter of the bore." All of the remaining claims include the limitations of either claim 19, claim 27 or claim 32. Thus, all of the present claims recite limitations wherein a spherical articulating portion touches a bore wall.

The Examiner has previously alleged that similar limitations are disclosed by Horber. Respectfully, Horber has been mischaracterized. Specifically, the Examiner has alleged that the articulation body 15 as shown in FIGs. 1, 3, 6 and 9 of Horber discloses a spherical articulating portion. Horber describes the articulation body 15 as including "circular edges 43." (Horber at paragraph 29). As set forth in Horber, "FIG. 5 clearly shows how the articulation surfaces 43 touch the conical lateral surface 25 in (sic) four points." (Horber at paragraph 43). Therefore, it is the articulation surfaces 43 which provide the contact between the articulation body 15 and the stem 11. As shown most clearly in FIGs. 1 and 2, the articulation surfaces 43 are cylindrical in shape, not spherical.

Therefore, since all of the present claims recite a limitation wherein the spherical articulating portion touches the bore, and Horber fails to disclose such an element, the Applicants respectfully submit that the new claims are patentable over Horber.

VI. The Claims are Not Obvious over Leonard in View of Horber.

Finally, the Examiner has determined that Leonard fails to disclose a spherical articulating portion of a mounting element that contacts a linearly extending interior wall. (Office Action at page 8). The Examiner has proposed, however, that the teaching of Horber provides motivation for modifying the device of Leonard with the teachings of Horber. Respectfully, Horber neither provides the alleged motivation nor the alleged teachings.

Specifically, the Examiner has cited to FIGs. 2, 3, 8 and 1/6 for teaching the use of a spherical bearing/articulation surface pressed into either a square, polygonal, spherical or tapered bore, respectively. The Applicants respectfully submit that FIGs 1-8 depict a single embodiment. FIG. 2 shows only the articulation body 15. (Horber at paragraph 42, FIG. 2). This is the *same* articulation body 15 shown in FIG. 1. (Horber at paragraph 9). FIG. 3 is the *same* articulation body 15 shown in FIG. 1. (Horber at paragraph 10). Finally, FIGs. 6 and 8 show the same endoprosthesis, without and with a cap and glenoid, respectively. (Horber at paragraphs 13 and 15). Moreover, the base part 11 and the articulation body 15 of FIGs. 6 and 8 are the *same* base part 11 and articulation body 15 of FIG. 1.

Therefore, rather than showing multiple combinations of geometries as alleged by the Examiner, FIGS. 1-8 of Horber disclose a single combination. Therefore, there is no

basis for the proposed modification of Leonard. Moreover, as discussed above, the components of Horber which contact the internal bore are the cylindrical articulation surfaces 43. Therefore, even if Leonard is modified to incorporate the cylindrical articulation members of Horber, such combination would not arrive at the invention recited in the present claims.

VII. Conclusion

Applicants respectfully request entry of the amendments and favorable consideration of the application.

A prompt and favorable action on the merits is requested.

Respectfully Submitted,
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